



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/672,136

09/26/2003

Lalitha Vaidyanathan

1018-001US03

6107

28863 7590 05/01/2009
SHUMAKER & SIEFFERT, P. A.
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125

EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3689

NOTIFICATION DATE

DELIVERY MODE

05/01/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pairedocketing@ssiplaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LALITHA VAIDYANATHAN,
JOHN QUINN, AHMED KHAISHGI, and
CARA CHERRY

Appeal 2008-1854
Application 10/672,136
Technology Center 3600

Decided:¹ April 29, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Lalitha Vaidyanathan, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 49-73. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.²

THE INVENTION

The claimed invention relates to an electronic dispute resolution system.

Claim 49, reproduced below, is illustrative of the subject matter on appeal.

49. A system comprising:
an online dispute resolution system
electronically coupled to an electronic
marketplace, wherein the electronic marketplace
stores transaction data that describes transactions
within the electronic marketplace between buyers
and sellers of goods or services,
wherein, in response to initiation of a
dispute, the online dispute resolution system
electronically receives at least a portion of the
transaction data stored within the electronic
marketplace without requiring manual entry of the
transaction data, and

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Sep. 14, 2006) and Reply Brief ("Reply Br.," filed Feb. 5, 2007), and the Examiner's Answer ("Answer," mailed Feb. 12, 2007).

wherein the dispute resolution system utilizes the received portion of the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Collins	US 2002/0007362 A1	Jan. 17, 2002
---------	--------------------	---------------

The Examiner takes Official Notice that “providing an indicia on a website is old and well known.” Answer 21. As evidence, the Examiner relies on copies of webpages attributed to the website www.truste.com and retrieved via a search for that site on the Internet archive site “Wayback Machine” for the period Jan. 1, 1996 to Sep. 15, 2005.

The following rejections are before us for review:

1. Claims 49-73 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 49-61 and 64-73 are rejected under 35 U.S.C. § 102(e) as being anticipated by Collins.
3. Claims 62 and 63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins and Official Notice.

ISSUES

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 49-73 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 49-61 and 64-73 under 35 U.S.C. § 102(e) as being anticipated by Collins.

The third issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 62 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Collins and Official Notice.

PRINCIPLES OF LAW

Written Description

“What is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue.”

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 736 (2002). All that is necessary to satisfy the description requirement is to show that one is “in possession” of the invention. The decision in *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997) accurately states the test.

One shows that one is “in possession” *of the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious. *Id.* (“[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.”) (emphasis in original). One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need not be used in *haec verba*, see *Eiselstein v. Frank*, 52 F.3d 1035, 1038 . . . (Fed.

Cir. 1995) (“[T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims”), the specification must contain an equivalent description of the claimed subject matter.

Lockwood v. Am. Airlines, Inc., 107 F.3d at 1572. Compliance with the written description requirement is a question of fact. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further

noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 49-73 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner argues that claims 49-73 contain “subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Answer 3. The Examiner argues that the claims on appeal were either the result of amendments to the originally-filed claims or were added during prosecution of the patent application. Answer 8. It is well established that “[w]hen the applicant adds a claim or otherwise amends his specification after the original filing date . . . the new claims or other added material must find support in the original specification.” *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. General Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001).

The question whether new matter has been added to an application is a question of fact. *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1574 (Fed. Cir. 1992). Here, the question is whether the Specification as originally filed contains a written description of the claimed subject matter of the claims on appeal sufficient to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed. *Cf. Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985,

993 (Fed. Cir. 1999). Compliance with the written description requirement is a question of fact. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985). To satisfy the written description requirement, the Appellants must “convey with *reasonable* clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*,” *Vas-Cath Inc.*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). (Emphasis added.) This is demonstrated by disclosure in the Specification. “Whether the written description requirement is satisfied is a fact-based inquiry that will depend on the nature of the claimed invention . . . and the knowledge of one skilled in the art at the time an invention is made and a patent application is filed.” *Carnegie Mellon University v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008). “The requirement is rigorous, but not exhaustive: “[I]t is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention.” *LizardTech*, 424 F.3d at 1345.” *In re Alonso*, 545 F.3d 1015, 1019 n.3 (Fed. Cir. 2008). The claimed subject matter need not be described “in haec verba” in the original specification in order to satisfy the written description requirement. *In re Wright*, 866 F.2d at 425. Rather, “the test . . . is whether a person of ordinary skill in the art would recognize that the applicant possessed what is claimed in the later filed application as of the filing date of the earlier filed application.” *Noelle v. Lederman*, 355 F.3d 1343, 1348 (Fed. Cir. 2004).

Turning now to the claims.

System claims 49-57, 64, 66, 70-73

Claim 49

The Examiner's position is set forth on pages 3-6 of the Answer. The Appellants' rebuttal is on pages 27-29 of the Appeal Brief. The Examiner's response is on pages 26-37 of the Answer. The Appellants' reply is on pages 12-13 of the Reply Brief.

Claim 49 reads as follows:

49. A system comprising:
an online dispute resolution system
electronically coupled to an electronic
marketplace, wherein the electronic marketplace
stores transaction data that describes transactions
within the electronic marketplace between buyers
and sellers of goods or services,
wherein, in response to initiation of a
dispute, the online dispute resolution system
electronically receives at least a portion of the
transaction data stored within the electronic
marketplace without requiring manual entry of the
transaction data, and
wherein the dispute resolution system
utilizes the received portion of the transaction data
in accordance with a dispute resolution process to
assist the buyers and sellers in resolving disputes
relating to the transactions.

According to the Examiner claim 49 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. "wherein the electronic marketplace stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services";

- b. “in response to initiation of a dispute, the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace”;
- c. “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data.”

Regarding the first limitation at issue, the Appellants direct attention to partner databases 164 in Fig. 2B. App. Br. 25 (“paragraph [0048] and FIG. 2 expressly describe[s] a partner system as having ‘partner databases 164’ FIG. 2B even shows a database storing partner data 164”). Since the claim literally recites “the electronic marketplace” stores the transaction data with no mention of “partner,” for the Appellants’ position to be persuasive as to error in the Examiner’s position, the partner system the Specification discloses in Fig. 2B must describe an electronic marketplace.

In that regard, the Appellants argue that the Specification provides strong evidence “indicat[ing] that [the] inventors contemplated that, in at least certain embodiments, the electronic marketplace 102 and its website described in FIG. 1 is an example of a partner system that may be integrated with the online dispute resolution system as shown in FIG. 2B.” App. Br. 24. Accordingly, the Appellants take the position that the claimed electronic marketplace is an embodiment of the partner system described in the Specification and, when viewed from that perspective, the electronic marketplace would possess the elements and characteristics of the partner

system, e.g., “storing transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services” as claimed.

The Examiner does not appear to have rebutted the Appellants’ position that the electronic marketplace of the claimed invention is an embodiment of the disclosed partner system. On page 30, the Examiner repeats the Appellant’s position but does not appear to dispute it. Other statements in the Answer appear to suggest that the Examiner agrees with the Appellants’ interpretation of what the Specification discloses (e.g., pp. 36-37: “The Examiner asserts that one of ordinary skill could not reasonable [(sic.), reasonably] conclude that the inventors were in possession of at least one embodiment in which data is communicated between system, e.g., from a partner data base 164 of a marketplace, as a partner system,”)

Be that as it may, we find the Specification conveys an electronic marketplace in connection with a dispute resolution system with reasonable clarity to those skilled in the art. Fig. 1 expressly illustrates an electronic marketplace (see e.g., element 102) in connection with a dispute resolution system (element 130). Regarding Fig. 2B that illustrates a “partner” system, according to [0047], the partner system contains objects to allow partners of the system to integrate with the dispute resolution system. The objects provide a functionality that informs the dispute resolution system of relevant “partner transactions” and allows partners to query the dispute resolution system data, such as the status of a “specific marketplace seller 104.” Seller 104 is depicted in Fig. 1 as interacting with the electronic marketplace 102 but is part of the marketplace (see [0041]). A server receives data from the objects in the partner system which in turn communicates with a data

manager 162 which further in turn communicates with partner databases 164. [0048.] “Partners integrate with the system, by exposing relevant functionality on their respective websites, for example, allowing customers to dispute a transaction.” [0048.] Importantly, the Specification states that the customers can “be either the seller or the buyer” ([0046]). Taken together, these disclosures with reference to a “partner” system convey an electronic marketplace with reasonable clarity to those skilled in the art.

Accordingly, since (i) the disclosed partner system conveys an electronic marketplace with reasonable clarity to those skilled in the art, (ii) the partner system comprises a database for handling partner transactions for customers, and (iii) the inherent function of a database is to store information, we find that the Specification provides written descriptive support for the first limitation at issue in compliance with the written description requirement of the first ¶ of § 112.

Regarding the second limitation at issue, it follows that if the partner system, which comprises a database for handling partner transactions for customers, allows customers to dispute a transaction via the online dispute resolution system, it would allow customers to interact with online dispute resolution system. Since this is accomplished via electronic means, it necessarily suggests that customers would be electronically communicating at least some data about the disputed transaction to the online dispute resolution system. Thus the Specification conveys an online dispute resolution system electronically receiving at least a portion of the transaction data stored within the electronic marketplace with reasonable clarity to those skilled in the art.

Regarding the third limitation at issue, we agree with the Examiner. We can find nothing whatsoever to suggest that “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data.” While we agree that the Specification conveys, with reasonable clarity to those skilled in the art, that a portion of the transaction data stored within the electronic marketplace is automatically and electronically received by the online dispute resolution system, the Specification does not convey that there is no requirement to manually enter transaction data. Since the Specification makes no mention of manually entering or not manually entering transaction data, there is no disclosure that would convey to those skilled in the art reading the Specification that the Appellants had possession of the claimed invention whereby at least a portion of the transaction data stored within the electronic marketplace is received by the online dispute resolution system without requiring manual entry of the transaction data.

The Appellants direct our attention to disclosure at [0047] of the Specification that describes the objects of the partner system “transparently deal with communication issues.” However, that tells us nothing about whether manual entry of transmission data is required or not. The cited disclosure might support the view that data passes seamless from the partner system to the dispute resolution system, but it provides no insight into a requirement for or against manual entry of data. While it may be obvious to conclude from this disclosure that manual entry would not be required, “[o]ne shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.”

Lockwood, 107 F.3d at 1572. *Citing Vas-Cath*, 935 F.2d at 1563-64.

Emphasis in original.

Accordingly, because we agree with the Examiner that the limitation “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 49 as failing to comply with the first paragraph of § 112.

Claim 50

The Examiner did not separately address claim 50. But because claim 50 depends on claim 49, and therefore includes all of the limitations set forth in claim 49, it suffers for the same reason as claim 49. Because we agree with the Examiner that the limitation “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” in claim 49 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 50 as failing to comply with the first paragraph of § 112.

Claim 51

The Examiner’s position is set forth on page 4 of the Answer. The Appellants’ rebuttal is on page 33 of the Appeal Brief. The Examiner’s

response is on pages 42-43 of the Answer. The Appellants' reply is on pages 17-18 of the Reply Brief.

Claim 51 reads as follows:

51. The system of claim 49, wherein the online dispute resolution system electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system.

According to the Examiner claim 51 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “the online dispute resolution system electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system.”

Regarding the limitation at issue, we agree with the Appellant (App. Br. 33) that Fig. 4 describes a process executed by the dispute resolution system involving a request by partner. Block 240 shows the initiation of a request and, via registration, that the partner is enrolled. The Specification at [0050] discusses Fig. 4 and refers to a “seller” providing “a request to initiate coverage.” The process in Fig. 4 is also described in relation to the system on Fig. 1, which figure shows an environment that supports an electronic dispute resolution. See [0039]. All the features of the limitation at issue appear to be disclosed as claimed. Accordingly, we find the Specification to convey the subject matter of the limitation at issue with reasonable clarity to those skilled in the art.

However, claim 51 depends on claim 49, and therefore includes all of the limitations set forth in claim 49, and thus suffers for the same reason as claim 49. Because we agree with the Examiner that the limitation “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” in claim 49 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 51 as failing to comply with the first paragraph of § 112.

Claim 52

The Examiner’s position is set forth on page 4 of the Answer. The Appellants’ rebuttal is on pages 29-30 of the Appeal Brief. The Examiner’s response is on pages 37-38 of the Answer. The Appellants’ reply is on pages 13-15 of the Reply Brief.

Claim 52 reads as follows:

52. The system of claim 49,
 wherein the online dispute resolution system
 comprises a membership profile database that
 maintains status information for the sellers and
 buyers of the marketplace that are members of the
 online dispute resolution system, and
 wherein the online dispute resolution system
 electronically communicates the status information
 to a database of the electronic marketplace.

According to the Examiner claim 52 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “wherein the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace.”

Regarding the limitation at issue, we agree with the Examiner.

We earlier found with respect to the second limitation of claim 49 at issue, that it followed that if the partner system, which comprises a database for handling partner transactions for customers, allows customers to dispute a transaction via the online dispute resolution system, it would allow customers to interact with the online dispute resolution system. Since this is accomplished via electronic means, we also found that it necessarily suggests that customers would be electronically communicating at least some data about the disputed transaction to the online dispute resolution system. Thus we found the Specification conveys an online dispute resolution system electronically receiving at least a portion of the transaction data stored within the electronic marketplace with reasonable clarity to those skilled in the art.

Here the issue is whether the Specification conveys communicating the status information to a database of the electronic marketplace. We do not find that the Specification conveys communicating the status information to a database of the electronic marketplace with reasonable clarity to those skilled in the art.

The Appellants refer us to the disclosure at [0048] of the Specification which discusses the data manager of the partner system communicating with partner databases. [0047] further explains there that the partner system includes software objects which provide functionality to inform the dispute

resolution system of transactions and to allow querying the dispute resolution system data about the status of a marketplace seller. But we do not take from this that “[t]his makes clear that the software objects executing on the marketplace system or any other partner system may electronically query (via SQL or other format) online dispute resolution system 130, receiving status of specific marketplace sellers 104 in response to that query and updating partner databases 164,” as the Appellants argue. App. Br. 29-30. This disclosure conveys that the information flows from the marketplace to the dispute resolution system. It does not convey with any reasonable clarity that the information flows in the opposite direction. That the system described may have that capacity is an argument that it would have been obvious to one of ordinary skill in the art reading the Specification to electronically communicate the status information to a database of the electronic marketplace from the online dispute resolution system. However, as we stated earlier in this decision, “[o]ne shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Lockwood*, 107 F.3d at 1572. *Citing Vas-Cath*, 935 F.2d at 1563-64. Emphasis in original.

Accordingly, we agree with the Examiner that the limitation “wherein the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace” in claim 52 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, and thus we affirm the rejection of claim 52 as failing to comply with the first paragraph of § 112 for that reason.

Furthermore, claim 52 depends on claim 49, and therefore includes all of the limitations set forth in claim 49, and thus claim 52 also suffers for the same reason as claim 49. Because we agree with the Examiner that the limitation “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” in claim 49 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 52 as failing to comply with the first paragraph of § 112 for this reason as well.

Claim 53

The Examiner’s position is set forth on page 4 of the Answer. The Appellants’ rebuttal is on pages 30-31 of the Appeal Brief. The Examiner’s response is on pages 39-40 of the Answer. The Appellants’ reply is on page 15 of the Reply Brief.

Claim 53 reads as follows:

53. The system of claim 49, wherein the online dispute resolution system further comprises a server to service electronic requests issued by a server within the electronic marketplace and to exchange data between the online dispute resolution system and the electronic marketplace.

According to the Examiner claim 53 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “a server to service electronic requests issued
by a server within the electronic marketplace

and to exchange data between the online dispute resolution system and the electronic marketplace.”

Regarding the limitation at issue, we agree with the Examiner.

Here the issue is whether the Specification conveys exchanging data between the online dispute resolution system and the electronic marketplace.

The Appellants again refer us to the disclosure at [0048] of the Specification which discusses the data manager of the partner system communicating with partner databases. [0047] further explains there that the partner system includes software objects which provide functionality to inform the dispute resolution system of transactions and to allow querying the dispute resolution system data. But we do not take from this that “[t]his makes clear that in the described second implementation data can be communicated in *both* directions between marketplace 102 and online dispute resolution system 130,” as the Appellants argue. App. Br. 30 (Appellants’ emphasis). This disclosure conveys that the information flows from the marketplace to the dispute resolution system. It does not convey with any reasonable clarity that the information flows in the opposite direction. That the system described may have that capacity is an argument that it would have been obvious to one of ordinary skill in the art reading the Specification to exchange data between the online dispute resolution system and the electronic marketplace. However, as we stated earlier in this decision, “[o]ne shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Lockwood*, 107 F.3d at 1572. *Citing Vas-Cath*, 935 F.2d at 1563-64. Emphasis in original.

Accordingly, we agree with the Examiner that the limitation “to exchange data between the online dispute resolution system and the electronic marketplace” in claim 53 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, and thus we affirm the rejection of claim 53 as failing to comply with the first paragraph of § 112 for that reason.

Furthermore, claim 53 depends on claim 49, and therefore includes all of the limitations set forth in claim 49, and thus claim 53 also suffers for the same reason as claim 49. Because we agree with the Examiner that the limitation “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” in claim 49 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 53 as failing to comply with the first paragraph of § 112 for this reason as well.

Claim 54

The Examiner’s position is set forth on page 4 of the Answer. The Appellants’ rebuttal is on page 31 of the Appeal Brief. The Examiner’s response is on page 40 of the Answer. The Appellants’ reply is on pages 15-16 of the Reply Brief.

Claim 54 reads as follows:

54. The system of claim 49, wherein the online dispute resolution system comprises a data

manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace.

According to the Examiner claim 54 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace.”

Regarding the limitation at issue, we agree with the Appellants that [0048] of the Specification describes, referring to Fig. 2B, a data manager 162 that communicates with partner databases 164. The data manager provides functionality to handle communicating data between the marketplace (via customers) and the dispute resolution system. Since claim 54 simply calls for communicating between the database of the marketplace and the dispute resolution system and does not further specify which information is communicated by and to whom (see e.g., claims 52 and 53), the limitation at issue is conveyed with reasonable clarity to those skilled in the art.

However, claim 54 depends on claim 49, and therefore includes all of the limitations set forth in claim 49, and thus suffers for the same reason as claim 49. Because we agree with the Examiner that the limitation “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” in claim 49 is not described

in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 54 as failing to comply with the first paragraph of § 112.

Claim 55

The Examiner's position is set forth on page 4 of the Answer. The Appellants' rebuttal is on pages 32-33 of the Appeal Brief. The Examiner's response is on pages 40-42 of the Answer. The Appellants' reply is on page 16 of the Reply Brief.

Claim 55 reads as follows:

55. The system of claim 49,
wherein the online dispute resolution system
electronically communicates rating data from a
database of the online dispute resolution system to
a database of the electronic marketplace,
wherein the rating data relates to
participation of the buyers and sellers of the
marketplace within the online dispute resolution
process.

According to the Examiner claim 55 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. "wherein the online dispute resolution system
electronically communicates rating data from a
database of the online dispute resolution system
to a database of the electronic marketplace."

Regarding the limitation at issue, we agree with the Examiner for the reasons discussed with respect to the limitation at issue for claim 52.

Here the issue is whether the Specification conveys communicating rating data to a database of the electronic marketplace. For the same reasons we did not find the Specification conveys status information to a database of the electronic marketplace (claim 52) with reasonable clarity to those skilled in the art, we similarly do not find that the Specification conveys communicating rating data to a database of the electronic marketplace with reasonable clarity to those skilled in the art.

Accordingly, we agree with the Examiner that the limitation “wherein the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace” in claim 55 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, and thus we affirm the rejection of claim 55 as failing to comply with the first paragraph of § 112 for that reason.

Furthermore, claim 55 depends on claim 49, and therefore includes all of the limitations set forth in claim 49, and thus claim 53 also suffers for the same reason as claim 49. Because we agree with the Examiner that the limitation “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” in claim 49 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 55 as failing to comply with the first paragraph of § 112 for this reason as well.

Claim 56

The Examiner did not separately address claim 56. But because claim 56 depends from claims 55 and 49, and therefore includes all of the limitations set forth in those claims, it suffers for the same reasons as claims 55 and 49. Because we agree with the Examiner that the limitation at issue for claim 55 and the limitation “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” in claim 49 are not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 56 as failing to comply with the first paragraph of § 112.

Claim 57

The Examiner did not separately address claim 57. But because claim 57 depends on claim 49, and therefore includes all of the limitations set forth in claim 49, it suffers for the same reason as claim 49. Because we agree with the Examiner that the limitation “the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” in claim 49 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 57 as failing to comply with the first paragraph of § 112.

Claim 64

The Answer does not present the Examiner's initial position as to claim 64. The Examiner's position is presented on pages 37-38 of the Final Rejection. We presume, as the Appellants seem to have done, that the Examiner intended to maintain that position. The Appellants provide a rebuttal on page 35 of the Appeal Brief. The Examiner responded on pages 48-50 of the Answer. The Appellants replied on page 20 of the Reply Brief.

Claim 64 reads as follows:

64. The system of claim 49, wherein the online dispute resolution system receives an electronic query from the marketplace and provides a status of a marketplace member of the marketplace in response to the query.

According to the Examiner claim 64 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. "the online dispute resolution system receives an electronic query from the marketplace."

Regarding the limitation at issue, we agree with the Appellants that the Specification conveys the subject matter of this limitation with reasonable clarity to those skilled in the art. The Specification at [0047] clearly describes allowing partners to query the dispute resolution system data.

However, claim 64 depends on claim 49, and therefore includes all of the limitations set forth in claim 49, and thus suffers for the same reason as claim 49. Because we agree with the Examiner that the limitation "the online dispute resolution system electronically receives at least a portion of

the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data” in claim 49 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 64 as failing to comply with the first paragraph of § 112.

Claim 66

The Examiner’s position is set forth on page 5 of the Answer. The Appellants’ rebuttal is on page 36 of the Appeal Brief. The Examiner’s response is on pages 51-52 of the Answer. The Appellants’ reply is on page 21 of the Reply Brief.

Claim 66 reads as follows:

66. A system comprising:
a dispute resolution system electronically coupled to an electronic marketplace for buyers and sellers of goods and services; and
a software application to automatically communicate transaction data from a database of the electronic marketplace to a database of the dispute resolution system in response to a transaction within the electronic marketplace by a member of the online dispute resolution system,
wherein the transaction data is associated with one or more transactions within the electronic marketplace, and
wherein the dispute resolution system utilizes the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.

According to the Examiner claim 66 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “a software application to automatically communicate transaction data from a database of the electronic marketplace to a database of the dispute resolution system in response to a transaction within the electronic marketplace by a member of the online dispute resolution system.”

Regarding the limitation at issue, the Appellants point to paragraphs [0046] and [0047] as describing a dispute resolution system with remote software objects allowing a partner system to send information to the online dispute resolution system about transactions within the partner system. App. Br. 36. We agree that the Specification indeed describes such a software object. The Appellants also point to [0056] of the Specification as describing “that, after a transaction, a buyer or a seller can dispute a transaction.” App. Br. 36. We have reviewed [0056]. It describes a complaint prefiling process, as shown in Fig. 6, whereby a buyer or seller may initiate a dispute and, via a complaint wizard, determine whether the dispute is eligible for acceptance by the dispute resolution system. However, we do not see from this disclosure of a software application that automatically communicates transaction data in response to a transaction within the electronic marketplace by a member of the online dispute resolution system. The Specification indeed discloses a software application to send information about a transaction but how or under what circumstances

the software application is to send the information is not explained. While the disclosure of a method to resolve disputes and a software application to send transaction data to a dispute resolution system might result in a software application which automatically communicates transaction data in response to a transaction within the electronic marketplace by a member of the online dispute resolution system obvious, “[o]ne shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Lockwood*, 107 F.3d at 1572. *Citing Vas-Cath*, 935 F.2d at 1563-64. Emphasis in original.

Accordingly, we agree with the Examiner that the limitation “a software application to automatically communicate transaction data from a database of the electronic marketplace to a database of the dispute resolution system in response to a transaction within the electronic marketplace by a member of the online dispute resolution system” in claim 66 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, and thus we affirm the rejection of claim 66 as failing to comply with the first paragraph of § 112 for that reason.

Claim 70

The Examiner’s position is set forth on page 6 of the Answer. The Appellants’ rebuttal is on pages 39-40 of the Appeal Brief. The Examiner’s response is on page 58 of the Answer. The Appellants’ reply is on page 22 of the Reply Brief.

Claim 70 reads as follows:

70. A system comprising:

an online dispute resolution system that presents an interface for receiving case information from one or more parties; and

an electronic marketplace system that includes:

a database that stores transaction data that describe transactions, and

a software object that automatically communicates the transaction data from the database to the online dispute resolution system when transactions within the electronic marketplace are performed by members of the online dispute resolution system,

wherein the online dispute resolution system executes a dispute resolution process that utilizes the transaction data and the dispute information to assist the parties in resolving the dispute.

According to the Examiner claim 70 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “an electronic marketplace system that includes[] a database that stores transaction data that describe transactions;” and,
- b. “a software object that automatically communicates the transaction data from the database to the online dispute resolution system when transactions within the electronic marketplace are performed by members of the online dispute resolution system.”

Regarding the first limitation at issue, we agree with the Appellants that the partner database described in the Specification teaches this limitation.

Regarding the second limitation at issue, we reach the same conclusion as we reached with respect to the similar limitation at issue with the subject matter of claim 66.

The Specification indeed discloses a software application to send information about a transaction but how or under what circumstances the software application is to send the information is not explained. While the disclosure of a method to resolve disputes and a software application to send transaction data to a dispute resolution system might result in a software application which would automatically communicate transaction data when transactions within the electronic marketplace are performed by members of the online dispute resolution system obvious, “[o]ne shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Lockwood*, 107 F.3d at 1572. *Citing Vas-Cath*, 935 F.2d at 1563-64. Emphasis in original.

Accordingly, we agree with the Examiner that the limitation “a software object that automatically communicates the transaction data from the database to the online dispute resolution system when transactions within the electronic marketplace are performed by members of the online dispute resolution system” in claim 70 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, and thus we affirm the rejection of claim 70 as failing to comply with the first paragraph of § 112 for that reason.

Claim 71

The Examiner's position is set forth on page 7 of the Answer. The Appellants' rebuttal is on pages 40-41 of the Appeal Brief. The Examiner's response is on pages 58-59 of the Answer. The Appellants' reply is on page 23 of the Reply Brief.

Claim 71 reads as follows:

71. A system comprising:
an online dispute resolution system having a
database of case information for a dispute; and
an electronic marketplace system that
includes:
a database that stores transaction data
that describe transactions for buyers and sellers,
a software object executing within the
electronic marketplace system that automatically
communicates the transaction data from the
database to the online dispute resolution system
without human intervention in response to
initiation of a dispute, and
a software object executing within the
electronic marketplace system that queries the
database of the online dispute resolution system
for status for at least one user of the electronic
marketplace system.

According to the Examiner claim 71 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. "a database that stores transaction data that describe transactions for buyers and sellers;"
- b. "a software object executing within the electronic marketplace system that automatically communicates the transaction

- data from the database to the online dispute resolution system without human intervention in response to initiation of a dispute;” and,
- c. “a software object executing within the electronic marketplace system that queries the database of the online dispute resolution system for status for at least one user of the electronic marketplace system.”

Regarding the first limitation at issue, we agree with the Appellants that the partner database described in the Specification teaches this limitation.

Regarding the second limitation at issue, we agree with the Examiner for the same reasons we gave with respect to claim 49 on a similar limitation. We can find nothing whatsoever to suggest that “a software object . . . that automatically communicates the transaction data from the database to the online dispute resolution system without human intervention” While we agree that the Specification conveys, with reasonable clarity to those skilled in the art, a software object automatically communicating transaction data, the Specification does not convey that this is done without human intervention. While it may be obvious to conduct an operation without human intervention where an automatic one is disclosed, it is not necessarily the case that an automatic operation excludes human intervention. Moreover “[o]ne shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Lockwood*, 107 F.3d at 1572. Citing *Vas-Cath*, 935 F.2d at 1563-64. Emphasis in original.

Regarding the third limitation at issue, this was addressed when we addressed claim 64. We agree with the Appellants that the Specification conveys the subject matter of this limitation with reasonable clarity to those skilled in the art. The Specification at [0047] clearly describes allowing partners to query the dispute resolution system data.

Accordingly, because we agree with the Examiner that the second limitation “a software object executing within the electronic marketplace system that automatically communicates the transaction data from the database to the online dispute resolution system without human intervention in response to initiation of a dispute” in claim 71 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 71 as failing to comply with the first paragraph of § 112.

Claim 72

The Examiner’s position is set forth on page 7 of the Answer. The Appellants’ rebuttal is on pages 41-42 of the Appeal Brief. The Examiner’s response is on page 59 of the Answer. The Appellants’ reply is on page 23 of the Reply Brief.

Claim 72 reads as follows:

72. A system comprising:
a server that provides an electronic marketplace system;
a plurality of client computers by which buyers and sellers interact with the electronic marketplace system; and
an online dispute resolution system having at least one server that communicates with a

database of the electronic marketplace system
without human intervention in response to
initiation of a dispute.

According to the Examiner claim 72 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “an online dispute resolution system having at least one server that communicates with a database of the electronic marketplace system without human intervention in response to initiation of a dispute.”

Regarding the limitation at issue, we agree with the Examiner for the same reasons we gave with respect to claims 49 and 71 on similar limitations. We can find nothing whatsoever to suggest that a “server that communicates with a database of the electronic marketplace system without human intervention ” The Specification does not convey a server communicating without human intervention. While it may be obvious to conduct an operation without human intervention where an automatic one is disclosed, it is not necessarily the case that an automatic operation excludes human intervention. Moreover, “[o]ne shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Lockwood*, 107 F.3d at 1572. *Citing Vas-Cath*, 935 F.2d at 1563-64. Emphasis in original.

Accordingly, because we agree with the Examiner that the limitation “an online dispute resolution system having at least one server that communicates with a database of the electronic marketplace system without human intervention in response to initiation of a dispute” in claim 72 is not

described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed, we affirm the rejection of claim 72 as failing to comply with the first paragraph of § 112.

Claim 73

The Examiner's position is set forth on page 7 of the Answer. The Appellants' rebuttal is on pages 18-27 of the Appeal Brief. The Examiner's response is on pages 59-61 of the Answer. The Appellants' reply is on pages 11-12 of the Reply Brief.

Claim 73 reads as follows:

73. A system comprising:
an online dispute resolution system that
executes a dispute resolution process; and
an electronic marketplace system that
includes:
(i) a web server that provides a centralized
trading place for a plurality of buyers and a
plurality of sellers,
(ii) a database that stores data, and
(iii) a software object that communicates the
data from the database to the online dispute
resolution system to inform the online dispute
resolution system of transactions performed by the
plurality of buyers and the plurality of sellers
within the electronic marketplace system.

According to the Examiner claim 73 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers;”
- b. “a database that stores data;” and,
- c. “a software object that communicates the data from the database to the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system.”

We find all these limitations are described in the Specification for essentially the reasons we stated with respect to the first two limitations at issue for claim 49. We find everything recited in this claim to be set forth in Figs. 1 and 2B and discussed in the Specification with respect to these figures.

The disclosed partner database 164 meets the claimed database that stores data. The electronic marketplace meets the claimed web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers. This especially is the case given the example of eBay.com. Specification [0040]. In that regard, one of ordinary skill in the art would understand that electronic marketplaces, like eBay.com, necessarily include databases, without which such sites cannot operate. A database is a “collection of related information about a subject organized in a useful manner that provides a base or foundation for procedures” (*Webster’s New World Dictionary of Computer Terms* 142 (Eighth Edition, 2000), entry for

“database.”) It is a fundamental aspect of sites like eBay.com that there be a database to collect related information about items to buy and sell and thereby provide a base for completing a transaction. The software object discussed at [0046] and [0047] of the Specification meets the claimed software object that communicates the data from the database to the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system.

Accordingly, we reverse the rejection of claim 73 as failing to comply with the first paragraph of § 112.

Method claims 58-63, 65, 67-69

Claim 58

The Examiner’s position is set forth on page 3 of the Answer. The Appellants’ rebuttal is on pages 27-29 of the Appeal Brief. The Examiner’s response is on pages 26-37 of the Answer. The Appellants reply is on pages 12-13 of the Reply Brief.

Claim 58 reads as follows:

58. A method comprising:
 providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace;
 electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic

marketplace in response to initiation of a dispute;
and

utilizing the received portion of the
transaction data in accordance with a dispute
resolution process to assist the users in resolving
disputes relating to the transactions within the
electronic marketplace.

According to the Examiner claim 58 fails to comply with the first
paragraph of § 112 because the following limitations are not described in the
Specification:

- a. “the electronic marketplace includes a database
that stores transaction data that describes
transactions within the marketplace;”
- b. “electronically receiving with the online dispute
resolution system at least a portion of the
transaction data from the database of the
electronic marketplace in response to initiation
of a dispute” and,
- c. “utilizing the received portion of the transaction
data in accordance with a dispute resolution
process to assist the users in resolving disputes
relating to the transactions within the electronic
marketplace.”

Regarding the first limitation at issue, we agree that Specification
conveys an “electronic marketplace includes a database that stores
transaction data that describes transactions within the marketplace” with
reasonable clarity to those skilled in the art. We incorporate herein the
reasoning we used for a similar limitation at issue for claims 49 and 73.

Regarding the second limitation at issue, we agree that Specification conveys “electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute” with reasonable clarity to those skilled in the art. We incorporate herein the reasoning we used for a similar limitation at issue for claim 49.

Regarding the third limitation, we find that given that the Specification conveys “electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute” with reasonable clarity to those skilled in the art, the Specification necessarily conveys “utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.” The entire Specification is directed to resolving disputes relating to the transactions within the electronic marketplace. If the Specification conveys “electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute,” as we have found, it necessarily follows that that the received portion is used to assist users in resolving disputes.

Accordingly, we reverse the rejection of claim 58 as failing to comply with the first paragraph of § 112.

Claim 59

The Examiner did not separately address claim 59. But because claim 59 depends from claims 58, and no subject matter of claim 59 is challenged as not being described in the Specification, we reverse the rejection of claim 59 as failing to comply with the first paragraph of § 112.

Claim 60

The Examiner's position is set forth on page 4 of the Answer. The Appellants' rebuttal is on page 33 of the Appeal Brief. The Examiner's response is on pages 42-43 of the Answer. The Appellants' reply is on pages 17-18 of the Reply Brief.

Claim 60 reads as follows:

60. The method of claim 58, further comprising:
electronically receiving with the online
dispute resolution system enrollment requests from
the sellers of the marketplace; and
automatically initiating enrollment of the
sellers within the dispute resolution system in
response to the requests.

According to the Examiner claim 60 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. "electronically receiving with the online dispute resolution system enrollment requests from the sellers of the marketplace[] and automatically initiating enrollment of the sellers within the dispute resolution system in response to the requests."

Regarding the limitation at issue, we treated the subject matter of this limitation when we addressed claim 51 above. For the reasons given there, we find the Specification to convey the subject matter of the limitation at issue with reasonable clarity to those skilled in the art.

Accordingly, we reverse the rejection of claim 60 as failing to comply with the first paragraph of § 112.

Claim 61

The Examiner's position is set forth on page 4 of the Answer. The Appellants' rebuttal is on pages 33-34 of the Appeal Brief. The Examiner's response is on pages 43-44 of the Answer. The Appellants' reply is on page 18 of the Reply Brief.

Claim 61 reads as follows:

61. The method of claim 58, further comprising:
electronically communicating data that
relates to the online dispute resolution process to
the database of the electronic marketplace, and
updating the electronic marketplace based
on the data received from the dispute resolution
system.

According to the Examiner claim 61 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. "electronically communicating data that relates
to the online dispute resolution process to the
database of the electronic marketplace, and
updating the electronic marketplace based on
the data received from the dispute resolution

system.”

Regarding the limitation at issue, we agree with the Examiner that the Specification does not convey updating the electronic marketplace based on the data received from the dispute resolution system. We can find nothing in the Specification about any updating procedure.

The Appellants direct our attention to discussion at [0053] in the Specification about updating a membership profile database. While that is an accurate characterization of what is described at [0053], that does not satisfy the requirement that the Specification describe “updating the electronic marketplace based on the data received from the dispute resolution system.” The discussion there describes a step by which “a” membership profile database is updated when a seller’s coverage by the dispute resolution system is accepted. But there is no explanation as to whether this membership profile database is an element of the electronic marketplace. Without that information, the Specification cannot convey updating the electronic marketplace based on the data received from the dispute resolution system with reasonable clarity to those of skill in the art.

Accordingly, we affirm the rejection of claim 61 as failing to comply with the first paragraph of § 112.

Claim 62

The Examiner’s position is set forth on page 5 of the Answer. The Appellants’ rebuttal is on pages 33-34 of the Appeal Brief. The Examiner’s response is on pages 44-46 of the Answer. The Appellants’ reply is on pages 18-19 of the Reply Brief.

Claim 62 reads as follows:

62. The method of claim 61, wherein updating the electronic marketplace comprises:

displaying in the electronic marketplace visual indicia associated with users of the electronic marketplace that participate in the dispute resolution system; and
controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes.

According to the Examiner claim 62 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes.”

Regarding the limitation at issue, the Appellants direct, in part, our attention to [0053] of the Specification. There it discloses that the process “sends indicia such as a medallion to be displayed on the seller’s point of sale.” We do not see in this disclosure “controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes.” It simply discloses sending. There is no disclosure about controlling the indicia’s appearance. The Appellants also discuss original claim 53 but we also do not see there any disclosure about “controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes.”

Also, claim 62 depends from claim 61 and therefore claim 62 fails to comply with the first paragraph of § 112 for same reasons claim 61 fails to comply.

Accordingly, we affirm the rejection of claim 62 as failing to comply with the first paragraph of § 112.

Claim 63

The Examiner's position is set forth on pages 4 of the Answer. The Appellants' rebuttal is on page 35 of the Appeal Brief. The Examiner's response is on pages 46-48 of the Answer. The Appellants' reply is on page 19 of the Reply Brief.

Claim 63 reads as follows:

63. The method of claim 58, further comprising embedding uniform resource locators associated with the dispute resolution system within a hypertext markup language application for the website of the electronic marketplace to enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace and file disputes without manually entering the transaction data into the dispute resolution system.

According to the Examiner claim 63 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. "without manually entering the transaction data into the dispute resolution system."

Regarding the limitation at issue, we addressed the subject matter of this limitation when we addressed claim 49. We reach the same conclusion.

We agree with the Examiner that the limitation “without manually entering the transaction data into the dispute resolution system” in claim 63 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed. Accordingly, we affirm the rejection of claim 63 as failing to comply with the first paragraph of § 112.

Claim 65

The Examiner’s position is set forth on page 5 of the Answer. The Appellants’ rebuttal is on pages 35-36 of the Appeal Brief. The Examiner’s response is on pages 50-51 of the Answer. The Appellants’ reply is on page 20 of the Reply Brief.

Claim 65 reads as follows:

65. The method of claim 58, further comprising:
receiving with the online dispute resolution system an electronic query from the electronic marketplace; and
electronically providing a status associated with one of the users from a database of the online dispute resolution system to the database of the electronic marketplace in response to the query.

According to the Examiner claim 65 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “receiving with the online dispute resolution system an electronic query from the electronic marketplace;” and,

- b. “electronically providing a status associated with one of the users from a database of the online dispute resolution system to the database of the electronic marketplace in response to the query.”

Regarding the first limitation at issue, we reach the same conclusion as we reached with respect to claim 64 above where a similar limitation was at issue. We agree with the Appellants that the Specification conveys the subject matter of this limitation with reasonable clarity to those skilled in the art. The Specification at [0047] clearly describes allowing partners to query the dispute resolution system data.

Regarding the second limitation at issue, we reach the same as we reached with respect to claim 52 above where a similar limitation was at issue. We agree with the Examiner that the Specification does not convey the subject matter of this limitation with reasonable clarity to those skilled in the art.

Claim 67

The Examiner’s position is set forth on page 5 of the Answer. The Appellants’ rebuttal is on page 37 of the Appeal Brief. The Examiner’s response is on pages 52-54 of the Answer. The Appellants’ reply is on page 21 of the Reply Brief.

Claim 67 reads as follows:

- 67. A method comprising:
 - providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which

users buy and sell items, wherein the electronic marketplace stores transaction data that describes transactions within the marketplace;
automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute; and
utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

According to the Examiner claim 67 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “the electronic marketplace stores transaction data that describes transactions within the marketplace;”
- b. “automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute;” and,
- c. “utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.”

Regarding the first and third limitations at issue, we agree with the Appellants that the Specification conveys the subject matter of these limitations with reasonable clarity to those skilled in the art for the reasons

discussed earlier in this decision with respect to similar subject matter for limitations at issue in other claims on appeal.

Regarding the second limitation at issue, we addressed the subject matter of this limitation when we addressed claim 49. We reach the same conclusion.

We agree with the Examiner that the limitation “automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute” in claim 67 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed. Accordingly, we affirm the rejection of claim 67 as failing to comply with the first paragraph of § 112.

Claim 68

The Examiner’s position is set forth on pages 5-6 of the Answer. The Appellants’ rebuttal is on pages 37-38 of the Appeal Brief. The Examiner’s response is on pages 54-55 of the Answer. The Appellants’ reply is on page 22 of the Reply Brief.

Claim 68 reads as follows:

- 68. A method comprising:
 - storing transaction data in an electronic marketplace, wherein the transaction data describes transactions within the electronic marketplace;
 - receiving case information with an online dispute resolution system, wherein the case information describes a dispute related to one of the transactions of the electronic marketplace;
 - automatically communicating at least a

portion of the transaction data related to the dispute from the electronic marketplace to the online dispute resolution system without manual intervention; and

executing a dispute resolution process with the online dispute resolution system that utilizes the transaction data from the electronic marketplace and the case information to assist in resolving the dispute.

According to the Examiner claim 68 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “storing transaction data in an electronic marketplace, wherein the transaction data describes transactions within the electronic marketplace;”
- b. “automatically communicating at least a portion of the transaction data related to the dispute from the electronic marketplace to the online dispute resolution system without manual intervention;” and,
- c. “executing a dispute resolution process with the online dispute resolution system that utilizes the transaction data from the electronic marketplace and the case information to assist in resolving the dispute.”

Regarding the first and third limitations at issue, we agree with the Appellants that the Specification conveys the subject matter of these limitations with reasonable clarity to those skilled in the art for the reasons

discussed earlier in this decision with respect to similar subject matter for limitations at issue in other claims on appeal.

Regarding the second limitation at issue, we addressed the subject matter of this limitation when we addressed claim 49. We reach the same conclusion.

We agree with the Examiner that the limitation “automatically communicating at least a portion of the transaction data related to the dispute from the electronic marketplace to the online dispute resolution system without manual intervention” in claim 68 is not described in the Specification so as to allow persons of ordinary skill in the art to recognize that the Appellants invented the subject matter that is claimed. Accordingly, we affirm the rejection of claim 68 as failing to comply with the first paragraph of § 112.

Claim 69

The Examiner’s position is set forth on page 6 of the Answer. The Appellants’ rebuttal is on pages 38-39 of the Appeal Brief. The Examiner’s response is on pages 55-58 of the Answer. The Appellants’ reply is on page 22 of the Reply Brief.

Claim 69 reads as follows:

- 69. A method comprising:
 - storing transaction data in a database of a electronic marketplace, wherein the transaction data describe transactions within the electronic marketplace;
 - receiving case information with an online dispute resolution system from one or more parties, wherein the case information describes a

dispute related to one of the transactions of the electronic marketplace; and
executing a dispute resolution process with the online dispute resolution system that receives at least a portion of the transaction data stored from the database of the electronic marketplace without human intervention in response to initiation of the dispute and uses the received portion of the transaction data and the case information from the parties to assist the parties in resolving the dispute.

According to the Examiner claim 69 fails to comply with the first paragraph of § 112 because the following limitations are not described in the Specification:

- a. “storing transaction data in a database of a electronic marketplace, wherein the transaction data describe transactions within the electronic marketplace;” and,
- b. executing a dispute resolution process with the online dispute resolution system that receives at least a portion of the transaction data stored from the database of the electronic marketplace without human intervention in response to initiation of the dispute and uses the received portion of the transaction data and the case information from the parties to assist the parties in resolving the dispute.

Regarding these limitations at issue, we agree with the Appellants that the Specification conveys the subject matter of these limitations with reasonable clarity to those skilled in the art for the reasons discussed earlier in this decision with respect to similar subject matter for limitations at issue in other claims on appeal.

Accordingly, we reverse the rejection of claim 69 as failing to comply with the first paragraph of § 112.

The rejection of claims 49-61 and 64-73 under 35 U.S.C. § 102(e) as being anticipated by Collins.

Every claim on appeal recites an “electronic marketplace” as a limitation to subject matter claimed. To be an anticipatory reference to the claimed subject matter, Collins must therefore teach an electronic marketplace. It does not do so.

The Examiner appears to be relying on [0045] as teaching an electronic marketplace. See Answer 12. The disclosure at [0045] does not teach an electronic marketplace. It teaches a “merchant” whose role is to maintain records concerning customers, including transactions that the customer has had with the merchant, such as the amount of merchandise purchased with the merchant, and an associated rating of the customer. [0047] of Collins teaches a method “for dispute resolution in connection with goods sold by a merchant over the Internet,” which may be read to teach the presence of “electronic” environment surrounding Collins’s method of dispute resolution. However, a “marketplace” is nowhere mentioned.

The Examiner was right to attempt to construe “marketplace” (see Answer 64).

A determination that a claim is anticipated under 35 U.S.C. § 102(b) involves two analytical steps.[□] First, the Board must interpret the claim language, where necessary. Because the PTO is entitled to give claims their broadest reasonable interpretation, our review of the Board's claim

construction is limited to determining whether it was reasonable. *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997). Secondly, the Board must compare the construed claim to a prior art reference and make factual findings that “each and every limitation is found either expressly or inherently in [that] single prior art reference.” *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

In re Crish, 393 F.3d 1253, 1256 (Fed. Cir. 2004). Footnote omitted.

However, we find that construing “marketplace” to encompass a merchant, per se, unreasonably broadens the scope of the term “marketplace.” Albeit the Specification does not provide an explicit definition for “marketplace,” it’s ordinary and customary meaning is “[a]n open area or square in a town where a public market or sale is set up” (see *The American Heritage Dictionary® of the English Language* (Fourth Edition, 2000.)(www.Bartleby.com.)(Entry 1. for “marketplace.”) In the context of an “electronic marketplace,” therefore, the claims are limited to an open and public market or sale in an electronic environment. Collins’s “merchant” falls short of being identical to a “marketplace,” as so limited. Given this restrictive definition for “marketplace,” a merchant, per se, is not inherently a marketplace. We do not find that Collins’s “merchant” necessarily has the open and public characteristics that would give it the semblance of a “marketplace” so recognized by persons of ordinary skill. Under principles of inherency, when a reference, said to be anticipatory prior art, is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir.

1991). While it may be possible that a merchant could be as open and public as a marketplace, “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Hansgirk v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted in *Continental Can Co.*, 948 F.2d at 1269. That is not to say that a merchant could not arguably conduct his or herself as openly and publicly as a marketplace, but that would require reading into Collins’s teaching of a merchant, per se, certain qualities and characteristics of a marketplace that a merchant, per se, may not necessarily have. “If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not § 102 anticipation, but § 103 obviousness.” *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1577 (Fed. Cir. 1991).

For the foregoing reasons, we reverse the rejection under § 102.

The rejection of claims 62 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Collins and Official Notice.

Claims 62 and 63 depend from claim 58, whose rejection under § 102 we reversed above. In making this rejection under § 103, the Examiner does not address the obviousness of an electronic marketplace, given the cited prior art, and thus does not overcome the aforescussed lack of a teaching of an electronic marketplace which the claimed subject matter requires. See pages 20-23 of the Answer. Accordingly, for the reasons we have given in reversing the rejection of claim 58, we also reverse the rejection of claims 62 and 63.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 58, 59, 60, 69, and 73 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 49-57, 61-68, and 70-72 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 49-61 and 64-73 under 35 U.S.C. § 102(e) as being anticipated by Collins and claims 62 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Collins and Official Notice.

DECISION

The decision of the Examiner to reject claims 49-73 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Appeal 2008-1854
Application 10/672,136

hh

SHUMAKER & SIEFFERT, P. A.
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125